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Mail Stop Appeal Brief:- Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450.

Re: Application Serial No.: 09/505,594  
Appellants: Jay Paul Drummond, et al.  
Filing Date: February 16, 2000  
Confirmation No.: 5969  
Title: Method and System For Connecting Services To  
Automated Transaction Machine  
Docket No.: D-1120 R1

Sir:

Please find enclosed the Appellants' Reply Brief pursuant to 37 C.F.R. § 41.41 for filing in the above-referenced application.

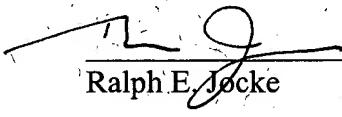
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Ralph E. Jockey  
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D-1120 R1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of: )  
**Jay Paul Drummond, et al.** )  
Serial No.: **09/505,594** )  
Confirm. No.: **5969** )  
Filed: **February 16, 2000** )  
For: **Method And System For** )  
**Connecting Services To An** )  
**Automated Transaction Machine** )  
                                    ) Art Unit 3624  
                                    )  
                                    ) Patent Examiner  
                                    ) **Narayanswamy**  
                                    ) **Subramanian**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41**

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 41.41 concerning the above-referenced Application. The Reply Brief is in response to the Examiner's Answer ("Answer") dated December 22, 2005.

In the Answer a new or modified ground of rejection appears to have been presented, but is not indicated as such. Appellants continue to respectfully submit that the claims are allowable. It is requested that the Appeal continue.

## **REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is  
Diebold, Incorporated, an Ohio corporation.

## **STATUS OF CLAIMS**

Claims 1-54 are pending in the Application.

Claims rejected: 1-11, 45 and 46

Claims allowed: none

Claims confirmed: none

Claims withdrawn: 12-44 and 47-54

Claims objected to: none

Claims canceled: none

## **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds to be reviewed in this appeal are:

- 1) Whether Appellants' claims 1-11, 45 and 46 are unpatentable under 35 U.S.C. § 103(a) over Coutts, et al., U.S. Patent No. 6,311,165 ("Coutts").

### **Additional Comment**

To support the "Official Notice" assertions in the Action (dated August 10, 2004) that were used as a basis for rejecting at least claims 1-9 and 46 over Coutts, the Examiner's Answer discusses (at page 8, lines 3-11; page 9, lines 4-12) the additional reference "Jini Device Architecture Specification Reference," Sun Microsystems, January 25, 1999 pages 6-9.

However, it is still unclear from the Examiner's Answer, whether the Office regards the Sun Microsystems reference as prior art. Also, the Examiner's Answer does not specifically reject claims 1-11, 45 and 46 over Coutts in view of Sun Microsystems reference. No new ground of rejection is specifically indicated in the Answer.

Although the Examiner's Answer is unclear in this regard, Appellants do not wish to delay consideration of the Appeal by the Board. Therefore Appellants will respond to the assertions in the Answer regarding the Sun Microsystems reference as though the Office intended to present a new or modified rejection such as: Claims 1-11, 45 and 46 are unpatentable under 35 U.S.C. § 103(a) over Coutts in view of the Sun Microsystems reference or an Official Notice assertion (supported by the Sun Microsystems reference).

Thus, it is presumed that additional grounds to be reviewed in this appeal are:

- 2) Whether Appellants' claims 1-11, 45 and 46 are unpatentable under 35 U.S.C. § 103(a) over Coutts in view of Sun Microsystems or an assertion of Official Notice (supported by the Sun Microsystems reference).

However, as the Examiner's Answer does not include a designated new ground of rejection, Appellants are not required to comply with 37 CFR §41.39(b)(2) in connection with this Reply Brief.

## **ARGUMENT**

The Answer includes a "Grounds of Rejection" section beginning on page 3. All of the grounds of rejection included in this section of the Answer are substantially identical to those previously presented in the Office Action dated August 10, 2004.

Appellants respectfully submit that these rejections have already been fully addressed in Appellants' Appeal Brief filed on December 23, 2004. Please refer to Appellants' previous arguments in the Appeal Brief regarding all the issues of record.

### **The Presumed New or Modified Grounds of Rejection in Answer**

Claims 1-11, 45 and 46 are presumed to have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Coutts in view of the Sun Microsystems reference or an Official Notice assertion (supported by the Sun Microsystems reference). These rejections are improper and should be reversed.

The following reply is directed to the new or modified grounds of rejection and associated arguments presented in the Answer. However, even though the present reply has been organized in a manner which addresses only the new or modified grounds of rejection and associated arguments presented in the Answer, Appellants do not waive their right to have all of their arguments presented in the Appeal Brief to be considered along with the arguments presented herein. If the Board has an unpublished policy which considers the format of the present reply to be a waiver of Appellants' right to have all of the separate arguments in the Appeal Brief be considered by the Board, then Appellants respectfully request that the Board so notify Appellants and provide an opportunity for Appellants to submit a revised Reply Brief.

### **Reply to the Answer's Response to Argument with Respect to Claims 1-3, 6-9 and 46**

Please note that the Appeal Brief includes a detailed discussion of the features and relationships recited in claims 1-3, 6-9 and 46 which are missing from Coutts. Please refer to the Appeal Brief with respect to the rejections of these claims in view of Coutts alone.

In the Answer's Response to Arguments section, the Answer acknowledges (at page 7, line 22 to page 8, line 3) that Coutts does not teach the feature recited in claim 1 of "the second transaction function device is operative to communicate a device driver from the second transaction function device to the data store for storage in the data store." However, the Answer continues to stand by the Examiner's "Official Notice" assertions in the Action (dated August 10, 2004 at page 4, lines 7-11) and in the Examiner's Answer at page 4, lines 6-9, that this feature "is old and well known in the art."

To support this Official Notice assertion, the Answer at pages 8 and 9, points to pages 6-8 of the newly cited Sun Microsystems reference. Appellants disagree that this newly cited reference supports the Official Notice assertions in either the Action or the Answer. In addition, Appellants disagree that the Official Notice assertion and/or that the Sun Microsystems references provide any prior art evidence that the recited features acknowledged as being missing from Coutts are known in the prior art. Further, Appellants disagree that any evidence of record supports the assertions in the Answer (page 4, lines 10-13) that it would have been obvious to one of ordinary skill in the art at the time of the invention to include in Coutts the recited features acknowledged as being missing from Coutts.

In Appellants' first Reply Brief dated August 3, 2005, Appellants pointed out that the Sun Microsystems reference does not qualify as prior art and further challenged the Office to establish

that the Sun Microsystems qualifies as prior art. However, nowhere in the present Answer does the Office even attempt to address, let alone establish, that the Sun Microsystems reference qualifies as prior art.

The present application claims the benefit of U.S. Provisional Patent Application No. 60/120,506 filed February 17, 1999 pursuant to 35 U.S.C. 119(e), and the rejected claims are fully supported by this provisional patent application. Although the Sun Microsystems reference includes a Revision 1.0 date which is purportedly January 25, 1999, neither the Sun Microsystems reference nor the Answer provide any evidence whatsoever as to when the Sun Microsystems reference was actually completed or publicly available.

For example, neither the Sun Microsystems reference nor the Answer provides any evidence as to when this reference was included in a published journal or was publicly available on an Internet web page. The purported "Revision 1.0" date of the reference is January 25, 1999, and Appellants' earliest priority date is February 17, 1999; however, a mere mention of a revision date may not be an accurate indication of when the material was created. Further, even if the revision date were possibly accurate, it does not indicate whether this is when the "revision" was begun or completed. In the case of the Sun Microsystems reference, nothing indicates whether the date corresponds to when the particular revision was begun or completed. Further, as revisions of documents can be done privately and non-publicly, Appellants respectfully submit that such a revision date does not provide evidence of a publication or public availability of the document. The date is clearly a "revision" date, not a publication date. Any document can be revised internally by a company numerous times and be associated with numerous revision dates prior to the document being published or being publicly available.

The Office has provided no evidence of the Sun Microsystems reference being published or publicly available prior to Appellants' earliest priority date. Nothing shows that the Sun Microsystems reference was publicly known or used prior to Appellants' effective filing date. As a result, the Office has failed to establish that this reference constitutes prior art to Appellants' invention. Appellants hereby again challenge the Office to make a showing that the Sun Microsystems reference is prior art to the present invention, and in the absence of such a showing request immediate allowance of the Application.

Appellants have attempted to determine the earliest publication date for the Sun Microsystems reference. Appellants have uncovered an Acrobat® PDF file entitled "deviceArch.pdf" which corresponds to the Sun Microsystems reference cited in the Examiner's Answer and which is available for download from the Internet. Appellants have attempted to locate the earliest existing copy of a web page which links to this PDF file. At one point, (although not as of July 25, 2005) there appears to have been a copy of the Sun Microsystems reference PDF file available at the URL: "<http://www.sun.com/jini/specs/deviceArch.pdf>." Because the U.S. Patent Office often relies on the "WayBackMachine" at the web site "[www.archive.org](http://www.archive.org)" to corroborate that a particular web page was accessible on the Internet at a particular prior art date, Appellants entered the URL: "<http://www.sun.com/jini/specs/deviceArch.pdf>" into the "WayBackMachine." The earliest date at which the PDF file corresponding to the Sun Microsystems reference was recorded by the "WayBackMachine" as being publicly available on the Internet was April 21, 2000, which is after Appellants' priority and filing dates. Also, for the years 1996-1999, the "WayBackMachine" shows "0 pages" corresponding to this URL. These results have been appended at the end hereof

as a courtesy to the Board so the members of the Board themselves may independently confirm these facts.

The failure by the Office to cite any evidence from its favorite source for Internet documents, the "WayBackMachine," to show this reference was available publicly prior to Appellants' priority date, constitutes an admission by the Office that this reference was not publicly available prior to Appellants' effective filing date.

The Sun Microsystems reference has not been shown by the Office to qualify as prior art. Therefore the Sun Microsystems reference cannot be used as a basis to support any of the Answer's "Official Notice" assertions; nor the Answer's assertion that the recited features missing from Coutts are known in the prior art; nor the Answer's assertion that it would have been obvious to one of ordinary skill in the art at the time of the invention to include in Coutts the recited features acknowledged as being missing from Coutts.

It is not stated in the Answer why the Office chose to only cite the Sun Microsystems reference as evidence to support an Official Notice assertion rather than to officially present a new ground of rejection based on the teachings of Coutts in view of the Sun Microsystems reference. However, it appears that the Office's decision to not directly cite the Sun Microsystems reference in a rejection may have been made because the Office recognizes that the Sun Microsystems does not qualify as prior art. Indeed it would be expected that the Office followed its usual practice and likely determined through the "WayBackMachine" that the Sun Microsystems reference is not prior art (as Appellants readily did). However, if that is the case, then the Office must also recognize that by not qualifying as prior art, the Sun Microsystems

reference then also cannot support the “Official Notice” assertions that the recited features acknowledged as being missing from Coutts are nevertheless known in the prior art.

Appellants have repeatedly challenged the Sun Microsystems reference, and the Office has repeatedly failed to show it constitutes prior art (because it is not). A non-prior art document clearly cannot be used to support an “Official Notice” rejection. MPEP § 2144.03. All rejections based on “Official Notice” which the Answer attempts to support by citation to the Sun Microsystems reference, are improper and should be reversed.

Appellants have been forced to speculate that perhaps the Office actually intended the Official Notice assertions to argue that the recited features acknowledged as being missing from Coutts may be inherent in Coutts. If so, Appellants strongly disagree.

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency, the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Nowhere does Coutts disclose or suggest features that would necessitate a second transaction function device to **communicate a device driver from the second transaction function device to the data store for storage in the data store**. The Answer’s assertion that "Communication of a device driver from the device to a data store helps in synchronization of

transaction events making the process more efficient" (page 4, lines 8-9) does not establish that communicating a device driver from a transaction function device to a data store is necessarily present in Coutts. Rather, the feature of Coutts that "helps in synchronization of transaction events making the process more efficient" is specifically taught in Coutts. This specific teaching in Coutts (which is opposite of the Appellants' recited feature) is that peripheral devices of an ATM (11) (Figure 1) individually download software modules from a remote server (16) (Column 3, lines 60-63; Column 8, lines 51-52; Column 9, lines 45-46). Thus the Appellants' recited feature of communicating a device driver from the second transaction function device to the data store is specifically shown as not used or necessary in Coutts, and therefore is not inherent in Coutts.

Appellants respectfully submit that the Answer has still failed to establish *prima facie* obviousness with respect to claims 1-3, 6-9, and 46. For this reason, the rejections of these claims should be reversed.

In addition, even if it were possible for the Sun Microsystems reference to qualify as prior art (which it does not) or for the Official Notice assertions to be accurate (which they are not), the Answer has still failed to show any prior art teaching, suggestion, or motivation to combine Coutts with the Sun Microsystems reference and/or to provide Coutts with the recited features admitted as being missing from Coutts.

For example, the Sun Microsystems reference does not disclose or suggest an automated transaction machine, which in the exemplary embodiment described in Appellants' Specification comprises an Automated Teller Machine (ATM). Further, the Sun Microsystems reference does not disclose or suggest using the described Jini™ architecture in an automated transaction

machine or an ATM. Similarly, Coutts does not disclose or suggest using the Jini™ architecture described in the Sun Microsystems reference. Also, Coutts does not disclose or suggest using the Jini™ architecture in an automated transaction machine or ATM. Thus neither Coutts nor the Sun Microsystems reference includes a prior art teaching, suggestion or motivation to combine the references in a manner which includes each and every feature and relationship recited in claim 1.

The Answer asserts that motivation to combine can be found in Coutts (Column 3, lines 18-26), where the Answer alleges there is a suggestion that each of the operating modules (peripheral devices) can be conveniently and independently updated using JAVA executable program code. However, neither this portion of Coutts nor any other portion of Coutts, nor any other applied prior art, discloses or suggests using the Jini™ architecture described in the Sun Microsystems reference in an ATM to provide the admittedly missing feature recited in claim 1.

The updating of JAVA executable code in the peripheral devices of Coutts as alleged in the Answer can be accomplished by the features explicitly disclosed in Coutts of an ATM (11) in which peripheral devices individually download software modules from a remote server (16) (Column 3, lines 60-63; Column 8, lines 51-52; Column 9, lines 45-46). As discussed in the Appeal Brief, Coutts teaches a system which has a direction of communication opposite to that of the recited invention. In Coutts, devices only download software from a server. Coutts does not disclose or suggest that the described system of downloading software modules from a remote server is insufficient to update executable code in peripheral devices. Thus the alleged motivation pointed out in the Answer is without basis and the Office has not established any

motivation for one or ordinary skill in the art to modify Coutts in view of the Sun Microsystems reference or the Official Notice assertion.

In addition, a reference teaching away from the recited invention does not support *prima facie* obviousness. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Coutts specifically teaches away from having transaction function devices communicate their device drivers to a data store, from which such device drivers are accessed by other transaction function devices. Rather Coutts expressly teaches that "Although the peripherals 364 are connected to the server 334 via the router 368, each peripheral 364 has independent access to the server 334 and is operable to download software modules directly therefrom (i.e. software modules are not first downloaded to an intermediate location and then copied to the peripherals 64 from the intermediate location)" (Column 21, lines 22-27). Thus, by stating that software modules are not downloaded to an intermediate location, Coutts not only fails to provide a teaching, suggestion, or motivation to modify Coutts as asserted by the Answer; Coutts also expressly discourages one of ordinary skill in the art from considering such modifications.

Coutts specially teaches that "By having a direct connection from the peripherals 364 to the server 334 it is possible to allow the peripheral software applications to take a more active role in the overall operational flow of the ATM 362. This allows the user interface processor to concentrate on its primary tasks of providing user interface display graphics, animation and video facilities. The processing power required to operate individual peripherals 364 can then be selected to optimize the cost/performance ratio" (Column 25, lines 5-13). This teaching of Coutts clearly argues the advantages and utility of downloading software modules from a remote

server **directly** to peripheral devices. Modifying Coutts as suggested in the Answer to communicate device drivers in the opposite direction to that expressly taught by Coutts would destroy the specific advantages and utility taught by Coutts. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). As the combination of features asserted in the Action would destroy the utility and advantages of the cited reference, it is respectfully submitted that the rejection is improper and should be withdrawn.

The attempts to combine the alleged teachings are clearly nothing more than attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992).

Appellants respectfully submit that the 35 U.S.C. § 103(a) rejections of claim 1 and dependent claims 2, 3, 6-9 and 46 over Coutts alone or in view of the Sun Microsystems reference or in view of the Official Notice assertion (supported by the Sun Microsystems reference) are not legally supported, improper and should be reversed.

#### **Reply to the Answer's Response to Argument with Respect to Claims 4 and 5**

Please note that the Appeal Brief includes a detailed discussion of the features and relationships recited in claims 4 and 5 which are missing from Coutts. Please refer to the Appeal Brief with respect to the rejections of these claims in view of Coutts alone.

In the Answer's Response to Arguments section, the Answer acknowledges (at page 8, lines 20-22) that Coutts does not teach the feature recited in claim 4 of "a second transaction function device to the data store for storage in the data store." However, claim 4 does not recite this language; rather, claim 4 recites a similar feature to that in claim 1 that is acknowledged by the Office as being missing from Coutts, which is "wherein the device computer processor associated with the second transaction function device is operative to cause the driver to be stored in the data store." Appellants presume that this feature recited in claim 4 was intended to be acknowledged as missing from Coutts, because it clearly is.

With respect to this feature recited in claim 4, the Answer appears to continue to stand by the Examiner's unfounded and improper "Official Notice" assertion as the basis for rejection. Further (as with claim 1), the Answer points to pages 6-8 of the Sun Microsystems reference to support the Official Notice assertions. Appellants disagree that this newly cited reference supports the Answer's Official Notice assertions and/or provides a prior art teaching, suggestion or motivation to modify Coutts to include this missing feature.

As discussed previously with respect to claim 1, the Answer provides no showing or argument that the Sun Microsystems reference is prior art to Appellants' invention. Indeed, it is not prior art. Thus, the Sun Microsystems reference cannot be used as a basis to support the Answer's "Official Notice" assertions and/or the Answer's presumed new or modified grounds of rejection based on Coutts in view of the Sun Microsystems reference or the Official Notice assertion (supported by the Sun Microsystems reference).

In addition, nowhere does Coutts disclose or suggest anything that would require that there would be necessarily present in Coutts a **device computer processor associated with the**

**second transaction function device being operative to cause the driver to be stored in the data store.** Thus this recited feature would not be inherent in Coutts.

Appellants respectfully submit that the Answer has still failed to establish *prima facie* obviousness with respect to claims 4 and 5. On this basis, the rejections of these claims should be reversed.

In addition, even if it were possible for the Sun Microsystems reference to qualify as prior art (which it does not) or for the Official Notice assertions to be accurate (which they are not), the Answer has still failed to show any prior art teaching, suggestion, or motivation to combine Coutts with the Sun Microsystems reference and/or the Official Notice assertion to provide Coutts with the recited features admitted as being missing from Coutts.

As discussed previously with respect to claim 1, the Sun Microsystems reference does not disclose or suggest an automated transaction machine, which in the exemplary embodiment described in Appellants' Specification comprises an Automated Teller Machine (ATM). Further, the Sun Microsystems reference does not disclose or suggest using the described Jini™ architecture in an automated transaction machine or an ATM. Similarly, Coutts does not disclose or suggest using the Jini™ architecture described in the Sun Microsystems reference. Also, Coutts does not disclose or suggest using the Jini™ architecture in an automated transaction machine or ATM. Thus neither Coutts nor the Sun Microsystems reference includes a prior art teaching, suggestion or motivation to combine the references in a manner which includes each and every feature and relationship recited in claim 4.

The Answer asserts that a motivation to combine can be found in Coutts (Column 3, lines 18-26) where it is allegedly suggested that each of the operating modules (peripherals devices)

can be conveniently and independently updated using JAVA executable program code. However, neither this portion of Coutts nor any other portion of Coutts discloses or suggests using the Jini™ architecture described in the Sun Microsystems reference in an ATM to provide the admittedly missing feature of Coutts that is explicitly recited in claim 4.

The updating of JAVA executable code in the peripheral devices of Coutts as alleged in the Answer can be accomplished by the features already disclosed in Coutts of an ATM (11) in which peripheral devices individually download software modules from a remote server (16) (Column 3, lines 60-63; Column 8, lines 51-52; Column 9, lines 45-46). As discussed in the Appeal Brief, Coutts teaches a system which has the opposite direction of communication compared to the recited invention. In Coutts, devices only download software from a server. Coutts does not disclose or suggest that the described system of downloading software modules from a remote server is in any way insufficient or inadequate for updating executable code in peripheral devices. Thus the alleged motivation conjured up in the Answer is without basis and is insufficient to establish any reasonable motivation to one of ordinary skill in the art to modify Coutts in view of the Sun Microsystems reference or the Official Notice assertion.

A reference teaching away from the recited invention does not support *prima facie* obviousness. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Coutts specifically teaches away from having transaction function devices cause their drivers to be stored in a data store from which they are acquired by other transaction function devices. In contrast, Coutts expressly teaches that "Although the peripherals 364 are connected to the server 334 via the router 368, each peripheral 364 has independent access to the server 334 and is operable to download software modules directly therefrom (i.e. software modules are not first downloaded to an intermediate

location and then copied to the peripherals 64 from the intermediate location)" (Column 21, lines 22-27). Thus, by stating that software modules are not downloaded to an intermediate location, Coutts not only fails to provide a teaching, suggestion, or motivation to modify Coutts as asserted in the Action; Coutts actually discourages one of ordinary skill in the art from considering such modifications.

In addition, Coutts specially teaches that "By having a direct connection from the peripherals 364 to the server 334 it is possible to allow the peripheral software applications to take a more active role in the overall operational flow of the ATM 362. This allows the user interface processor to concentrate on its primary tasks of providing user interface display graphics, animation and video facilities. The processing power required to operate individual peripherals 364 can then be selected to optimize the cost/performance ratio" (Column 25, lines 5-13). This passage clearly argues the advantages and utility of downloading software modules from a remote server **directly** to peripheral devices. Modifying Coutts as asserted in the Answer to have transaction function devices cause their drivers to be stored in a data store from which they are acquired by other transaction function devices, would destroy the specific advantages and utility taught by Coutts. As the combination of features asserted in the Action would destroy the utility and advantages of the cited reference, it is respectfully submitted that the rejection is improper and should be reversed.

The attempts to combine the alleged teachings are clearly nothing more than attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992).

Appellants respectfully submit that the 35 U.S.C. § 103(a) rejections of claim 4 and dependent claim 5 over Coutts alone or in view of the Sun Microsystems reference or in view of the Official Notice assertion (supported by the Sun Microsystems reference) are improper and should be reversed.

**Reply to the Answer's Response to Argument with Respect to Claims 10, 11, and 45**

Please note that the Appeal Brief includes a detailed discussion of the features and relationships recited in claims 10, 11 and 45 which are missing from Coutts. Please refer to the Appeal Brief with respect to the rejections of these claims in view of Coutts alone.

Appellants disagree with the Answer's assertion at page 9, line 12, that the Abstract of Coutts discloses steps by which the first transaction function device is operative to communicate a device driver from the first transaction function device to at least one other transaction function device; and the at least one of the device computers of the at least one other transaction function device is operative responsive to the device driver communicated from the first transaction function device to communicate with the first transaction function device. Nowhere in the Abstract or elsewhere, does Coutts disclose or suggest these features.

The Coutts Abstract states that "the individual peripheral devices can be connected to each other over the link to enable them to communicate directly with each other on a peer-to-peer basis." Such a teaching does not disclose or suggest communicating a device driver between individual devices. Rather, Coutts only teaches having the peripheral devices of an ATM (11) (Figure 1) individually download software modules from a remote server (16) (Column 3, lines 60-63; Column 8, lines 51-52; Column 9, lines 45-46). Nowhere does Coutts disclose or suggest

that his "peer-to-peer basis" of communication includes communicating device drivers between peripheral devices.

Further, Appellants' recited features would not be inherent in Coutts. For example, in Coutts the software modules downloaded directly to the peripheral modules from the remote server could include all the necessary programming to enable them to communicate directly with each other on a peer-to-peer basis. Nowhere does Coutts disclose or suggest features that would make it necessary to have transaction function devices communicate their device drivers to other transaction function devices. Therefore, this recited feature of Appellants' claim 10 which has been shown to not be disclosed or suggested in Coutts, is also not inherent in Coutts.

In addition, at page 9, line 20, the Answer appears to suggest that the "Official Notice" assertions argued with respect to the rejections of claims 1-9, and 46 in combination with Coutts apply to claims 10, 11, and 45 as well. However as discussed previously, the newly cited reference of Sun Microsystems does not support the Answer's Official Notice assertions. Further, Appellants disagree that the Sun Microsystems reference or the Official Notice assertions (supported by the Sun Microsystems reference) provide any prior art teaching, suggestion or motivation to modify Coutts to include the features and relationships recited in claims 10, 11, and 45.

As discussed previously with respect to claim 1, the Sun Microsystems reference is not prior art to Appellants' application and also does not disclose or suggest an automated transaction machine or an ATM. Further, the Sun Microsystems reference does not disclose or suggest using the described Jini™ architecture in an automated transaction machine or an ATM. Similarly, Coutts does not disclose or suggest using the Jini™ architecture described in the Sun

Microsystems reference. Also, Coutts does not disclose or suggest using the Jini™ architecture in an automated transaction machine or ATM. Thus neither Coutts nor the Sun Microsystems reference include a prior art teaching, suggestion or motivation to combine the references in a manner which includes each and every feature and relationship recited in claim 10.

Also as discussed previously, Coutts teaches a system which has the opposite direction of communication compared to the recited invention. In Coutts, devices only download software from a server. Coutts does not disclose or suggest that one of its peripheral devices "is operative to communicate a device driver from" the peripheral device to "at least one other" peripheral device.

Thus, given that Coutts specifically teaches the advantages of directly downloading software modules from a remote server to the peripheral devices (Column 3, lines 26-37), Appellants respectfully submit that there is no motivation provided in Coutts to cause one skilled in the art of automated transaction machines or ATMs to disregard the specific teachings of Coutts and to look to the Sun Microsystems reference (which is not prior art in any event) to create Appellants' claimed automated transaction machine which communicates device drivers between devices rather than from a remote server.

The attempts to combine the alleged teachings are clearly nothing more than attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992).

Appellants respectfully submit that the 35 U.S.C. § 103(a) rejections of claim 10 and dependent claims 11 and 45 over Coutts alone, or in view of the Sun Microsystems reference, or

in view of the Official Notice assertion (supported by the Sun Microsystems reference), are improper and should be reversed.

### **Additional Comments regarding the New Arguments in the Answer**

The discussion of the Examiner's "Official Notice" assertions and presumed new or modified grounds of rejection included in the Answer have been discussed previously. They are not supported and are without merit. In addition, Appellants do not agree with the Examiner's summary of Appellants' arguments. Also, Appellants disagree that Coutts teaches all of the features recited in the claims, except for those features specifically admitted in the Answer as being missing.

The Examiner's Answer does not even argue that the Sun Microsystems reference shows any of the other features and relationships which are pointed out in the Appeal Brief as missing from Coutts, and which are expressly recited in Appellants' claims 1-11, 45 and/or 46. Thus, Appellants respectfully submit that the Answer and prior Actions have not established *prima facie* obviousness with respect to the pending claims.

### **CONCLUSION**

Appellants have responded to the claim rejections (as best understood) in spite of the Office's failure to clearly state how the Answer can rely on the non-prior art Sun Microsystems reference to support Official Notice assertions. The evidence of record and the statutory tests all establish that Appellants' claimed invention is patentable. Allowance of all the pending claims is respectfully requested.

Respectfully submitted,

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